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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,156	10/19/1998	KEITH LYNN PUTNAM	98.P.7912.US	6575

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/19/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/175,156

Applicant(s)

PUTNAM ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on Marcy 11, 2003. **Claims 1-21** are now pending in the present application.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 10,12-15,22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Milewski US Patent 6,519,326.

Regarding claim 10, Milewski teaches a telephony device (155,160) for playing a customized message to a caller, (abstract; col. 4, lines 46-51), comprising:

a ring detector generating a detection signal in response to an incoming call, (col. 3, lines 47-55; call request signal is detected);

a ringer (voice-ringer) alerting a called party to the incoming call in response to the detection signal, (col. 3, lines 49-55; col. 6, lines 15-32; a voice-ring announcement is played over a telephone speaker);

a command interface (fig. 2) for receiving one or more message parameters from the called party, (col. 4, lines 1-7; col. 5, line 63-col. 6, line 7); and

a controller for activating the command interface in response to the detection signal and for transferring, even in an instance in which the called party intends not to answer the incoming call, (the called party can ignore the incoming call and send a message notifying the calling party that they will not answer, col. 6, lines 3-7), the customized message to the caller, the customized

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message been customized according to the message parameters, wherein the controller is an element of a telephone (computer/telephone), (col. 5, lines 63-col. 6, line 7; fig. 3).

Regarding claim 12, Milewski, as applied to claim 10, teaches an audio interface for receiving a spoken message from the called party, (col. 4, lines 46-51).

Regarding claim 13, Milewski, as applied to claim 12, teaches a memory for storing the spoken message, (database 108; col. 2, lines 44-53; col. 4, lines 21-27).

Regarding claim 14, Milewski, as applied to claim 10, teaches a keypad permitting the called party to manually enter the message parameters, (col. 5, line 63-col. 6, line 7).

Regarding claim 15, Milewski, as applied to claim 10, teaches a caller identification unit for displaying caller information to the called party, (fig. 2).

Regarding claim 22, Milewski, as applied to claim 10, teaches wherein the ring detector is configured to detect the incoming phone call based on the incoming call itself, (col. 3, lines 49-55; col. 6, lines 15-32).

Regarding claim 23, Milewski, as applied to claim 22, teaches wherein the ring detector is configured to detect a ring signal of the incoming telephone call, (col. 3, lines 49-55; col. 6, lines 15-32).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-9,20,21 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams US Patent 6,400,814 in view of Wolff et al. US Patent 5,327,486.

Regarding claim 1, Adams teaches a system for responding to an incoming call, (fig. 6; col. 2, lines 51-64) from a calling party, comprising:

means (telephone 10/call controller 36) for receiving the incoming phone call, (col. 4, lines 4-25);

means for generating a user alert in response to the incoming phone call, (col. 6, lines 3-37);

means for enabling selective entry of a user message (transfer-to-voicemail command message) entered in response to the alert while the incoming call is pending and still ringing to the calling party (col. 6, lines 14-60; call continues to ring until after the user sends a user message).

Adams does not specifically teach of playing the selected user message to the calling party.

Wolff teaches that it was well known in the art to response to an incoming call by selected a user message and means for playing the user message to the calling party, (col. 5, lines 4-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Adams by playing the selected message to the calling party as taught by Wolff so that the calling party will know how their call is being processed e.g. transferring to voice mail or that the called party is busy.

Regarding claim 2, Adams in view of Wolff teach means for releasing the call after playing the message, (col. 6, lines 27-37).

As shown above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Adams by playing the selected message to the calling party as taught by Wolff so that the calling party will know how their call is being processed e.g. transferring to voice mail or that the called party is busy.

Regarding claim 3, Adams teaches means for displaying caller identification information to the user, (col. 6, lines 3-14).

Regarding claim 4, Adams teaches wherein the receiving means includes means for activating a user command interface for a predetermined period of time following commencement of the user alert, (col. 6, lines 3-14).

Regarding claims 5 and 6, Adams, as applied above does not specifically teach wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command.

Wolff teaches that it was well known in the art to have receiving means which includes a voice recognition unit for recognizing at least one spoken command, (col. 7, lines 17-22) and wherein the at least one spoken command includes a predetermined instruction (verbal command) and a variable parameter, (col. 6, lines 17-36; col. 7, lines 5-22; figs. 8 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Adams by using speech recognition as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device. This is to make certain that the called party is an authorized user of the receiving device..

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Regarding claim 7, Adams teaches wherein the receiving means includes means for manually selecting the user message, (col. 5, lines 15-46).

Regarding claims 8 and 9, Adams, as applied above, does not specifically teach of recording an audio user message.

Wolff teaches that it was well known in the art to have means for recording an audio user message, (col. 5, lines 57-65; col. 7, lines 17-22) so that a user can send the user message to a calling party, (col. 5, lines 1-6,57-65) and means for storing the user message, (col. 5, lines 1-6,57-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Adams by recording an audio user message as taught by Wolff so that a user can pre-recorded customized user responses for specific callers.

Regarding claim 20, Adams teaches wherein the system is incorporated within a telephone, (fig. 3).

Regarding claim 21, Adams teaches wherein the command interface receives the message parameters from the called party while the incoming call is not yet connected, (col. 5, lines 14-46).

Regarding claim 25, Adams in view of Wolff, as applied to claim 1, teaches wherein said means for playing the user message to the calling party is configured to cause playing the user message to the calling party in some instances in which the user refuses to answer the incoming phone call, (fig. 8; col. 6, lines 37-45).

As shown above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Adams by playing the selected message to the

calling party as taught by Wolff so that the calling party will know how their call is being processed e.g. transferring to voice mail or that the called party is busy.

Regarding claim 26, Adams, as applied to claim 1, teaches wherein the means for generating a user alert in response to the incoming phone call comprises means for detecting the incoming phone call based on the incoming phone call itself, (col. 4, lines 4-25).

Regarding claim 27, Adams, as applied to claim 26, teaches wherein the means for detecting the incoming phone call comprises means for detecting a ring signal of the incoming telephone call, (col. 4, lines 4-25).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Wolff.

Regarding claim 11, Milewski does not specifically teach of using voice recognition for receiving spoken commands that include message parameters.

Wolff teaches a voice recognition unit for receiving spoken command (col. 7, lines 17-22) that include the message parameters, (col. 6, lines 17-36; col. 7, lines 5-22; fig. 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Milewski by using voice recognition to receive spoken commands as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device. This is to make certain that the called party is an authorized user of the receiving device.

7. Claims 16-19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weishut US Patent 6,047,057 in view of Wolff.

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Regarding claim 16, Weishut teaches a method for presenting an audio message to a telephone caller, (fig. 5; col. 2, lines 22-32), comprising:

detecting, at a recipient telephone, an incoming telephone call, based on the incoming phone call itself, (col. 3, lines 25-45);

generating, from the recipient telephone, a user alert in response to the incoming call, (col. 2, lines 7-21; col. 3, lines 25-55);

receiving a command from a called party in response to the user alert, (col. 4, lines 2-10; col. 4, lines 50-58).

Weishut does not specifically teach generating an audio message based on the command.

Wolff teaches that it was well known in the art to receive a command from the user and to generate an audio message based on the command, (col. 5, lines 1-6,57-65); answering the incoming call, (col. 5, lines 4-6); and playing the audio message to the telephone caller, (col. 5, lines 4-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Weishut by generating an audio message and playing the selected message to the calling party as taught by Wolff so that the calling party will know how their call is being processed e.g. transferring to voice mail or that the called party is busy and so that the called party can create customized voice responses to the caller.

Regarding claims 17 and 18, Weishut, as applied to claim 16, does not specifically teach of using voice recognition.

Wolff teaches activating a voice recognition unit to receive a command. (col. 7, lines 17-22; col. 6, lines 17-36; col. 7, lines 5-22; fig. 8). Wolff further teaches recording a spoken

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message from the called party and including the spoken message in the audio message, (col. 5, lines 1-6,57-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Weishut by using voice recognition to receive spoken commands as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device. This is to make certain that the called party is an authorized user of the receiving device.

Regarding claim 19, Weishut, as applied to claim 16, teaches manually entering the command using a keypad, (col. 5, lines 50-58).

Regarding claim 24, Weishut, as applied to claim 16, teaches wherein the detecting step detects the incoming telephone call by detecting a ring signal of the incoming telephone call, (col. 3, lines 25-45).

Response to Arguments

8. Applicant's arguments filed April 1, 2004 have been fully considered but they are not persuasive.

Regarding claims 10, 12-15, Applicants contend that Milewski does not teach "even in an instance in which the called party intends not to answer the incoming call" since Milewski specifically teaches away from such feature by teaching that its call answer message is specifically to signal that the call is to be accepted. The Examiner respectfully disagrees.

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While the amendment necessitated the new grounds of rejection, the Examiner has clarified the office action to include a new citation in which a user in Milewski can ignore the call and send a message.

Regarding claim 1-9, 20 and 21, Applicants contend that Adams does not teach means for enabling selective entry of a user message entered...while the incoming call is pending and still ringing. The Examiner respectfully disagrees.

Given the broad scope of "message" the Examiner believes since a user can input a command for the switch when the incoming call is ringing/alerting the user then the command to the switch reads on a selected user message.

The Applicants also stated that there is no basis in Adams to suggest that turning off the ringer of the telephone is in any way whatsoever an "entering" of a "user message" that it to be "played" or even sent. The Examiner agrees in part.

The Examiner agrees, as stated in the office action, that Adams fails to teach of the user message being played. However, the Examiner believes that Adams at least teaches means for enabling selective entry of a user message entered in response to the alert while the incoming call is pending and still ring to the calling party since as stated in the office action the user is alerted and during the alerting process the user can send a command to the switch (reads on a user selected message (transfer-to-voicemail) since a command reads on a message).

In regards to claim 21, Applicant states that it is not known how Adams can teach something "after playing the message " given that there is no playing the message is Adams.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner did not state in the Office Action that Adams teaches of playing a message. The claim rejection to claim 1 and 21 is based upon the combination of Adams and Wolff. Since claim 1, modifies the Adams reference to include sending a user message to be played to the calling party as taught by Wolff then claim 21 is met since Adams in view of Wolff teach of releasing the call after the message is played as shown in the Office Action.

Regarding claims 16-19, Applicants contends that Weishut does not teach “detecting, at a recipient telephone, an incoming telephone call, based on the incoming phone call itself”. The Examiner respectfully disagrees.

As stated in the office action the recipient telephone is able to alert the user that an incoming call is arriving. Since the telephone is alerting the user of an incoming call then the incoming call itself triggers the incoming call alerting.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., basic telephone without external signaling infrastructure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ovidio Escalante
Examiner
Group 2645
May 14, 2004

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante